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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,663	10/17/2001	Masato Nogawa	30033.0004	7649

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EXAMINER

PETERSON, KENNETH E

ART UNIT PAPER NUMBER

3724

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,663

Applicant(s)

NOGAWA ET AL.

Examiner

Kenneth E Peterson

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 and 16-54 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 18-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02jan04</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant has amended the elected claims such that they are no longer drawn to the elected invention. By adding the receiving means, Applicant has shifted from the elected subcombination (group I) to the non-elected combination (group II). This is acceptable, as per MPEP 806.05(c), example 3, which states that if the subcombination is found to be not allowable, rejoinder of the combination should be considered. In this case, the subcombination was found to be not allowable in the rejection mailed 23 December 04. Claims 11-13, 16 and 17 of group II have been rejoined to group I for examination below.

Claims 14, 18 and 19 of group II, along with claims 20-32, belong to yet another (previously unidentified) combination/subcombination group having an air evacuation means, separable as per MPEP 806.05(c), and thus stay non-elected.

2. The information disclosure statements filed 02 jan 04 and 05 mar 02 fail to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but only the American patents, and two foreign references (DE 19843011 and EP 0584602) have been considered.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art, as set forth on pages 1-5 of Applicant's specification, and in Applicant's figures 9 and 10. The admitted prior art discloses all of the recited features except that the booklet bundle height is inputted by the operator to control the pressing plate (18) height, instead of being automatically inputted by a first measuring means.

Examiner takes Official Notice that it is well known to control the pressing plate height based upon sensors that measure the height of the incoming work to be pressed. An example of such is the patent to Sebelist et al. '542, which teaches height sensors (54) that in turn control the height of the pressing plate (14), as set forth on lines 30-37 of column 2. It would have been obvious to one of ordinary skill in the art to have modified Applicant's admitted prior art by adding a height sensor to control the pressing plate height, as is old and well known and taught by Sebelist, in order to further automate the device, thus increasing operating speed and decreasing human requirements.

In regards to claim 10, the admitted prior art books are considered to be "counted" as per page 11 of Applicant's specification, since neither Applicant's specification nor claims disclose any counting structure that is not shown by the admitted prior art. If it is interpreted that the specification somehow infers some structure that is not shown by the admitted prior art, then Examiner takes Official Notice

that it is old and well known to electro-mechanically count the items in a stacks based on stack thickness. For example, Examiner has seen coin counters that work this way. It would have been obvious to one of ordinary skill in the art to have modified the admitted prior art by replacing it's counting system with an electro-mechanical counting system based on stack height, as is well known, in order to alleviate the machine operator from having to perform this task.

5. Applicant's arguments have been fully considered but they are not persuasive.

Applicant has shown proof that he submitted his foreign priority documents. Examiner has combed thru the electronic AND paper files and has not found this document. Please accept our apologies for having lost it. At this point, the Examiner need merely see a photocopy of the foreign priority papers, to verify that it is drawn to the same invention as the current application.

In any response to this action, please submit a photocopy of the foreign priority papers.

Applicant has provided the concise explanation for two of the foreign pieces of prior art, and these two have now been initialed on the 1449 form. The other three pieces of foreign prior art have still not been considered.

Applicant's new abstract is acceptable.

Applicant argues that the combination of the admitted prior art and Sebelist does not disclose the subject matter of the claims, as now amended. In particular, Applicant seems to be relying on the structure to adjust the height of the movable block, as

claimed in the last paragraph of claim 9. However, this recitation is set forth in the *alternative* with the adjustment of the pressing plate, and therefore only one of the two features need be shown by the prior art. If Applicant would like to claim both of these adjustments, then Applicant should have used the term "and" and not used the term "or".

6. Made of record but not relied on is the patent to Mohr showing a pertinent height measuring mechanism.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson at 571-272-4512, on Monday-Thursday, 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached at 571-272-4514. In lieu of mailing, it is encouraged that papers be faxed to 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see <http://pair-direct.uspto.gov> or call the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kp
May 27, 2005



KENNETH E. PETERSON
PRIMARY EXAMINER